

REMARKS

The Office action has been carefully considered. In the Office Action dated October 10, 2006, Claims 7-9, 31-33, and 50-52 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0083435 A1 to Blasko et al. ("Blasko"). Claims 1-6, 11-19, 21-30, 35-43, 45-49, and 53-55 were rejected under 35 U.S.C. §103(a) as being obvious over Blasko in view of U.S. Patent Application No. 2005/0226142 A1 to Rand. Claims 10, 20, 34, and 44 were rejected under 35 U.S.C. §103(a) as being obvious over Blasko in view of Rand and in further view of U.S. Patent No. 6,950,623 to Brown ("Brown"). Applicants respectfully disagree.

By present amendment, claims 7, 31, and 50 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

35 U.S.C. §102 Rejections

Turning to the claims, amended claim 7 recites:

In a client system, a method of operation comprising:
 adaptively retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system;
 providing an advertisement publisher with a profile of the user of client system;
 caching said plurality of advertisements of various time lengths;
and
 causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot.

Claims 31 and 50 recite similar language. The Office Action rejected claims 7, 31, and 50 as being anticipated by Blasko. In specific, the Office Action contends that Blasko teaches adaptively retrieving a plurality of advertisements in a manner

that is consistent with a quality objective for receiving and rendering said streaming program on said client system. Par. 29, lines 4-15, par. 33, lines 10-14, par. 46, par. 57, and par. 60 of Blasko are referenced. Further, the Office Action contends that Blasko teaches caching said plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Further yet, the Office Action contends that Blasko teaches causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 26 to par. 27 of Blasko is referenced. Applicants respectfully disagree.

Blasko teaches a system for “targeted advertising, such as in television programming, such as in television programming delivery systems utilizing set top boxes” (STB). Among other differences, the cited and applied reference fails to teach, disclose or suggest the element of “providing an advertisement publisher with a profile of the user of client system” from a client system as claimed in amended independent Claims 7, 31, and 50. Nor does the cited and applied reference teach, disclose, or suggest sending any subscriber information from a client system. As discussed more fully below, Claims 7, 31, and 50, and their dependent claims clearly recite such elements and the Office Action has admitted that similar recitation in other pending independent claims are not taught by Blasko.

More specifically, as described in the Application, what is claimed is a method, apparatus and system that includes “providing an advertisement publisher with a profile of the user of client system.” Blasko merely uses predetermined demographic information: “advertisements that have been selected or prepared to interest particular subscribers identified, for instance, using geo-demographic information, are inserted into TV programming streams for the identified subscribers by a TV service provider” (Paragraph 7). Alternately, in Blasko, “ad selection and insertion can occur at the household level wherein each household ad insertion device (e.g., a STB) receives a plurality of ads from an ad source, such as the network, and selects ads that are most appropriate for the viewer in the household based on predetermined ad selection criteria” (Paragraph 7). In fact, Blasko has no

mention or suggestion of client system provided profile or subscriber information. Clearly, Blasko does not teach all of the recitations of claim 1. In fact, The Office Action admits that similar recitations in claims 1, 25, and 49 (*i.e.*, providing an advertisement publisher with a profile of the user of client system) are not taught by Blasko. Therefore, applicants submit that claims 7, 31, and 50 are allowable over the prior art of record for least these reasons.

Applicants respectfully submit that dependent claims 8-9, 32-33, and 51-52 by similar analysis, are allowable. Each of these claims depends directly from its respective independent claim, (claims 7, 31, or 50) and consequently includes the recitations of its independent claim. As discussed above, Blasko fails to disclose the recitations of these independent claims and therefore these dependent claims are also allowable over the prior art of record. In addition to the recitations of claim 7, 31, and 50 noted above, each of these dependent claims includes additional patentable elements.

For example, Claims 8, 32, and 51 include “monitoring one or more performance metrics that are indicative of whether the client system is meeting said performance objective for receiving and rendering said streaming program.” Blasko also fails to teach such monitoring. The portion of Blasko that was cited as teaching “monitoring” (paragraphs 41-46) has no mention of monitoring, let alone “monitoring one or more performance metrics that are indicative of whether the client system is meeting said performance objective for receiving and rendering said streaming program.” it merely states that it is possible to determine if a television is turned on. For this reason as well, in addition to those already noted above, Claims 8, 32 and 51 are in condition for allowance.

In another example, Claims 9, 33, and 52 include “adjusting at least one of an operational bit rate and an operational pulse rate.” Blasko also fails to teach such adjusting. The portion of Blasko that was cited as teaching “adjusting” (paragraphs 44 and 46) has no mention of adjusting either an “operational bit rate” or an “operational pulse rate” as part of adaptively retrieving an advertisement. Yet again, Blasko merely states that it is possible to determine if a television is turned on. For

this reason as well, in addition to those already noted above, Claims 9, 33 and 52 are in condition for allowance.

35 U.S.C. §103 Rejections

Turning to the claims rejected under §103, claim 1 recites:

In a client system, a method of operation comprising
providing an advertisement publisher with a profile of the
user of client system;
caching a plurality of advertisements of various time
lengths; and
causing one or more of said cached advertisements to be
synchronously rendered during an advertisement time slot of a
streaming program, replacing advertisements, if any, included in the
streaming program for the advertisement time slot.

The Office Action rejected claim 1 as being unpatentable over Blasko in view of Rand. In specific, the Office Action contends that Blasko teaches caching a plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Further, the Office Action contends that Blasko teaches causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Par. 26 to par. 27 of Blasko is referenced.

The Office Action acknowledges that Blasko fails to teach providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation at par. 11, par. 20, lines 1-5, at par. 22. The Office Action concludes that the recitations of claim 1 would have been obvious to one skilled in the art at the time of the invention because the selective insertion of media data into a data stream as taught by Rand yields the advantage of optimally customizing a subscriber's data stream by analyzing content preferences and demographic profiles. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981,

180 USPQ 580 (CCPA 1974)), and “all words in a claim must be considered in judging the patentability of that claim against the prior art;” (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office Action has failed to establish a *prima facie* case for obviousness. There is no teaching anywhere in Blasko, Rand, or any other prior art of record that teaches or even suggests the concept of providing an advertisement publisher with a profile of the user of the client system. Furthermore, even if one were to construe the cited and applied sections of Rand to somehow teach this recitation, the motivation to combine these two references, as cited in applied by the office action, is highly suspect. These prior art limitations are discussed further below.

Blasko teaches a system and method for injecting advertisements into a stream of television programming upon the detection of a display device being on and currently operating. Such a system is able to detect whether or not a display device associated with a set top box (STB) is turned on and currently receiving and displaying a signal from the STB. As such, a head end programming provider is better able to determine whether or not injected advertising will actually be seen based on the assumption that if a display device is turned on then an audience is watching. Detecting whether or not a display devices on, however, simply does not reveal any meaningful demographic information about any such viewing audience. That is, absolutely no information about a profile related to a user of the system can be construed, and subsequently provided to an advertising publisher, simply by detecting whether or not the display device is on or off.

The Office Action contends that Blasko does, in fact, teach dealing with a user profile by reference to a profiling module 322 of figure 2 and the fact that Blasko teaches including demographic information when identifying whether or not an STB

is currently operating. This is an erroneous conclusion. Despite mentioning the word demographic information, Blasko is merely referring to the geographic information, *i.e.*, the particular location of the detected STB. This kind of geographic information reveals nothing about the profile of the user of the system. Furthermore, Blasko only makes passing mention of its profiling module in a laundry list of components that may be included in its system of figure 2. There is actually no further mention of the profiling module and it is quite unclear as to exactly how Blasko is using this device that it refers to as a profiling module. Absent any further description, it would be impermissible for the office action to interpret the words "profiling module" to mean "providing an advertisement publisher with a profile of the user of client system" as recited in claim 1.

Rand does not remedy this deficiency in the teachings of Blasko. Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscriber's predetermined preferences. In specific, paragraph 20 of Rand describes that insertion of media may be based on a number of factors including age, education, sex, viewing history, and geographic location. Delving further into Rand however, it is stated that this kind of subscriber preference data is stored in a metadata module 135 which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network is capable of "providing an advertisement publisher with a profile of the user of client system" as recited in claim 1. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone "providing an advertisement publisher with a profile of the user of client system."

In the Office Action, it is correctly recognized that Blasko does not teach or suggest providing an advertisement publisher with a profile of the user of client system. However, in the Office Action it is stated that Blasko combined with the teaching of Rand would remedy this deficiency. Applicants respectfully disagree. Nowhere in Rand, let alone in the cited paragraphs (11, 20, and 22) is there a teaching of "providing an advertisement publisher with a profile of the user of client

system.” Therefore, each and every element of claim 1 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Furthermore, to suggest that one skilled in the art would have obviously looked to a system that has already assembled and stored information about a subscriber such as the case in Rand to be combined with a system of Blasko to actively look to retrieve information that has already been retrieved is illogical. Rand does not teach providing a profile in about a subscriber to an advertisement publisher because Rand has already separately and distinctly assembled its own set of profile data. It is overly broad and conclusive to simply show that a system uses profile information (Rand) and then turn around and construe using profile information to be the same as a system that is capable of "providing an advertisement publisher with a profile of the user of client system.” Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as Rand has absolutely no need for seeking additional duplicative profile information.

Applicants respectfully submit that dependent claims 2-6 and 10-24 by similar analysis, are allowable. Each of these claims depends directly from claim 1 and consequently includes the recitations of claim 1. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. Even when additional prior art is introduced, as is the case with Brown as cited in applied with regard to claims 10 and 20, the prior art of record still fails to teach or suggest all of recitations of the pending claims. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 25 recites:

An apparatus comprising:
storage medium having stored therein programming instructions designed to enable the apparatus to provide an advertisement publisher with a profile of the user of client system;
cache a plurality of advertisements of various time lengths, and
synchronously render one or more of said cached advertisements during an advertisement time slot of a streaming program, to effectively substitute for advertisements, if any, included in said streaming program for rendering during said advertisement time slot; and
at least one processor coupled with the storage medium to execute the programming instructions.

The Office Action rejected claim 25 as being unpatentable over Blasko in view of Rand. In specific, the Office Action contends that Blasko teaches storage medium having stored therein programming instructions designed to enable the apparatus to cache a plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Further, the Office Action contends that Blasko teaches causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Par. 26 to par. 27 of Blasko is referenced.

The Office Action acknowledges that Blasko fails to teach providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation at par. 11, par. 20, lines 1-5, at par. 22. The Office Action concludes that the recitations of claim 25 would have been obvious to one skilled in the art at the time of the invention because the selective insertion of media data into a data stream as taught by Rand yields the advantage of optimally customizing a subscriber's data stream by analyzing content preferences and demographic profiles. Applicants respectfully disagree.

Again, to establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and “all words in a claim must be considered in judging the patentability of that claim against the prior art;” (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office Action has failed to establish a *prima facie* case for obviousness. As discussed above, there is no teaching anywhere in Blasko, Rand, or any other prior art of record that teaches or even suggests the concept of providing an advertisement publisher with a profile of the user of the client system. Furthermore, even if one were to construe the cited and applied sections of land to somehow teach this recitation, the motivation to combine these two references, as cited in applied by the office action, is highly suspect.

Blasko teaches a system and method for injecting advertisements into a stream of television programming upon the detection of a display device being on and currently operating. Such a system is able to detect whether or not a display device associated with a set top box (STB) is turned on and currently receiving and displaying a signal from the STB. Detecting whether or not a display device is on, however, simply does not reveal any meaningful demographic information about any such viewing audience.

Rand does not remedy this deficiency in the teachings of Blasko. Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscriber's predetermined preferences. Delving further into Rand however, it is stated that this kind of subscriber preference data is stored in a metadata module 135, which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network is capable of " providing an advertisement

publisher with a profile of the user of client system” as recited in claim 25 1. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone “providing an advertisement publisher with a profile of the user of client system.”

In the Office Action, it is correctly recognized that Blasko does not teach or suggest providing an advertisement publisher with a profile of the user of client system. Nowhere in Rand, let alone in the cited paragraphs (11, 20, and 22) is there a teaching of “providing an advertisement publisher with a profile of the user of client system.” Therefore, each and every element of claim 25 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Furthermore, to suggest that one skilled in the art would have obviously looked to a system that has already assembled and stored information about a subscriber such as the case in Rand to be combined with a system of Blasko to actively look to retrieve information that has already been retrieved is illogical. It is overly broad and conclusive to simply show that a system uses profile information (Rand) and then turn around and construe using profile information to be the same as a system that is capable of “providing an advertisement publisher with a profile of the user of client system.” Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as Rand has absolutely no need for seeking additional duplicative profile information.

Applicants respectfully submit that dependent claims 26-30 and 34-48 by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 25 and consequently includes the recitations of claim 25. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 25 and therefore these claims are also allowable

over the prior art of record. Even when additional prior art is introduced, as is the case with Brown as cited in applied with regard to claim 34 and 44, the prior art of record still fails to teach or suggest all of recitations of the pending claims. In addition to the recitations of claim 25 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 49 recites:

A system comprising:
 first server providing
 at least one of advertisements of various time
lengths, and locations of advertisements of various time lengths to a
client;
 second server providing
 a streaming program to said client, said streaming
program having one or more advertisement time slots; and
 said client coupled with the first and second servers to
 provide an advertisement publisher with a profile
of a user of said client;
 cache said advertisements of various time lengths,
and
 synchronously render one or more of said cached
advertisements during an advertisement time slot to effectively
substitute for advertisements, if any, included in said streaming
program for rendering during said advertisement time slot.

Claim 49 recites a similar language to claims 1 and 25 including the recitation "provide an advertisement publisher with a profile of a user of said client." The Office Action acknowledges that Blasko does not teach this recitation. Rand does not remedy this deficiency in the teachings of Blasko. Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscribers' predetermined preferences. Rand teaches that this kind of subscriber preference data is stored in a metadata module 135 which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network that can "provide an advertisement publisher with a profile of the user of client system" as recited in claim 49. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no

communication in Rand with the advertisers 170, let alone “providing an advertisement publisher with a profile of the user of client system.” Therefore, each and every element of claim 49 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Furthermore, to suggest that one skilled in the art would have obviously looked to a system that has already assembled and stored information about a subscriber such as the case in Rand to be combined with a system of Blasko to actively look to retrieve information that has already been retrieved is illogical. It is overly broad and conclusive to simply show that a system uses profile information (Rand) and then turn around and construe using profile information to be the same as a system that is capable of “providing an advertisement publisher with a profile of the user of client system.” Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as Rand has absolutely no need for seeking additional duplicative profile information.

Applicants respectfully submit that dependent claims 53-55, by similar analysis, are allowable. Each of these claims depends directly from claim 49 and consequently includes the recitations of claim 49. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 49 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 49 noted above, each of these dependent claims includes additional patentable elements.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

CONCLUSION

Applicants submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

Respectfully submitted,

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Date: December 11, 2006

by: /Kevin D. Jablonski/

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